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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,997

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Andreas Eipper

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4348

30678

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EXAMINER

LEE, DORIS L

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

1. Applicant's response filed March 5, 2010 has been fully considered but is not persuasive for the reasons set forth below:

2. **Applicant's argument:** Gareiss, when compared to the presently claimed invention, there is no provision of a thermoplastic polyester molding composition with the highly branched or hyper branched polycarbonates, or any indication that highly branched or hyper branched polycarbonates are obtainable by a low-cost simple industrial process.

Examiner's response: Gareiss teaches that the thermoplastic molding composition is open to the addition of various additives (Abstract) and Davis teaches that the additive can be the hyper branched polymer. Applicant's argument that Gareiss does not suggest the hyper branched polymer is not persuasive because in a 103(a) rejection one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

3. **Applicant's argument:** Examiner uses hindsight reasoning, there is no indication or expectation of achieving a composition with the great properties as claimed by the present invention.

Examiner's response: *In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction*

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based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In response to applicant's argument that the prior art does not teach the improved properties as shown by the applicant, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

4. **Applicant's argument:** The polycarbonates of Davis are completely different than the presently claimed polycarbonates.

Examiner's response: *Although Davis uses a different, more complex and more costly synthetic route than that of the presently claimed invention, it is the examiner's position that the end products of the hyper branched polymer of Davis and that of the presently claimed invention are identical in structure. As the claims of the present invention are compositional claims, patentability of said claim is based on the recited product and does not depend on its method of production. Since the product claimed is the same as product disclosed by Davis the claim is unpatentable even though the Davis product was made by a different process. In re Marosi, 710 F2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.*

5. **Applicant's argument:** Applicant's request that the double patenting rejections to be held in abeyance.

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Examiner's response: *The double patenting rejections cannot be held in abeyance and as such are maintained.*

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/
Examiner, Art Unit 1796

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/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796